

REMARKS

Claims 1-7 remain pending in this application. Claims 1-3 and 6 are rejected. Claims 4, 5 and 7 are objected to. Claims 1-7 are amended herein to express the invention in alternative wording, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims and objections cited in the above-referenced Office Action.

Applicant submits herewith a substitute specification and abstract wherein amendments are effected to place the text thereof into proper English in accordance with 37 CFR 1.125(c). Also accompanying this amendment is a reproduction of the original specification and abstract with markings indicating the amendments effected in the substitute specification in accordance with MPEP §608.01(q) and 37 CFR 1.125(b). No new matter is added. Entry of the substitute specification and abstract is respectfully requested.

Additionally, replacement sheets of Figs. 1 and 2, wherein legends “PRIOR ART” are added, are appended hereto to properly reflect the written disclosure. Entry of these replacement sheets is earnestly solicited.

The claims are objected to due to various informalities including inferential claiming of elements and lacking or improper antecedent bases. The claims are

amended to address the informalities. Accordingly withdrawal of the objections is respectfully requested.

Claims 1-3 and 6 are rejected as obvious over Codos (US 2002/0,005,870) in view of Jones (US 5,468,080) under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness is not established in rejection of claims 1-3 and 6. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

The Examiner admits that Codos et al. does not teach the use of motors and sensors for the supply roller mechanism and the take-up mechanism or rewinding

roller mechanism. In an attempt to overcome this deficiency, Jones is offered as allegedly providing these missing features. However, Jones is limited to providing teaching relating to control of tension of a supply roller 12 and a supply motor (not shown in reference), as noted by the Examiner (citing to col. 3, lines 52-53). The Office Action does not point to anything offered in the disclosure of Jones that would indicate teaching relating to such a control mechanism provided also for a take-up mechanism or rewinding roller mechanism. While the Examiner apparently argues “[T]he use [of] motors and sensors for controlling the feeding of a web” (emphasis added) as being, in general, known in the art, he offers nothing in the way of support as to why one skilled in the art would be lead to provide an additional tension control arrangement suited specifically for the purposes of monitoring and controlling rewinding of the fed material, in addition to the feeding, when apparently no such mechanism for such purpose is taught by Jones. Therefore, the proffered combination of references fails to teach or suggest all claimed elements, as properly required for establishing a *prima facie* case of obviousness.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1-3 and 6 and their allowance are respectfully requested.

Claims 4, 5 and 7 are objected to as being dependent from rejected base claims. In this regard, applicant notes that the Office Action inconsistently indicates in the Detailed Action that claims 3, 4 and 7 avoid the prior art, when applicant

believes that claim 4, 5 and 7 are the claims that are intended by the Examiner as being held to contain allowable subject matter. This conclusion is based upon the statement of reasons for allowable subject matter, as well as the further rejections of claims 1-3 and 7 addressed above. The Examiner indicates that the claims contain allowable subject matter (treated herein as claims 4, 5 and 7), and would be allowed if put in independent form incorporating the limitations of the base and intervening claims. Claims 4, 5 and 7 are amended in accordance with the Examiner's suggestion. Reconsideration of the objections and allowance of the claims are respectfully requested.

One (1) further independent claim in excess of three is added. Accordingly, please charge the fee of \$210 to Deposit Account No. 10-1250.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg b.y.
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicant
and,

By Lawrence Wechsler
Lawrence Wechsler
Reg. No. 36,049
Attorney for Applicant

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Replacement drawing sheets of Figs. 1 and 2; Substitute Specification and abstract; and Marked reproduction of original specification and abstract.